

III. REMARKS

Claims 1-4, 6-8 and 10-22 are pending in this application. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Furthermore, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is requested.

Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C 103(a) as being unpatentable over Machin et al. (US 6,877,034), hereinafter “Machin”, in view of Sanders (US 6,411,936), hereinafter “Sanders.”

A. §112, first paragraph, Rejection of Claims 1-4, 6-8 and 10-22

Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Office asserts that the “number of metrics and solutions for a given industry is endless,” and

further alleges “[t]here is nothing in the specification that clearly sets forth steps one would take to enable them to assess the impact of all possible solutions.” Office Action, page 4, item 7.

Applicant respectfully traverses the rejection and submits that the specification clearly meets the enablement requirement. Specifically, one of ordinary skill in the art of, for example, business management would be enabled to practice the claimed invention, based on the specification along with his/her business management knowledge, at the time of the invention. Applicant contends that the foundation of the Office’s rejection rests, in large part, on its fallacious contention that because there are an “endless” number of possibly metrics and solution and that the specification does not disclose steps to assess impact on “all possible solutions.” First, applicant respectfully contends that the Office, in making its rejection, is creating a threshold of proof that is not only, not statutorily required, but is also illogical because it is unobtainable. Simply put, to write a specification that would address each and every way (e.g., solution) to practice something in a claim, would be virtually infinite in length. It is both inherent and logical that the specification must merely provide enough information so that one of ordinary skill is able to practice the claimed invention. The Applicant has met that burden.

To this extent, Applicant respectfully submits that the claimed invention is clearly enabled in the specification and/or with the knowledge of one of ordinary skill in the art

of business management at the time of the invention. Accordingly, Applicant requests that the rejection be withdrawn.

B. §112, second paragraph, Rejection of Claims 1-4, 6-8 and 10-22

Claims 1-4, 6-8 and 10-22 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office asserts that the “body of the claim does not meet the objective of the claim preamble”, because “it is not clear how identifying a solution to address exposed performance gaps will result in improving the business value of company.” Office Action, page 5, item 9. The Office ultimately seeks clarification based on an alleged inconsistency that [w]hile some operational metrics may affect a company’s business value, there are many other factors ... that will affect the business value of a company.” Office Action, page 5, item 9.

Applicant respectfully traverses the rejection and submits that the claims are not indefinite. Specifically, even assuming *arguendo* that the Office’s assertion that “other factors” may affect the business value beyond “operational metrics” is correct, the assertion is a moot point. The claimed invention speaks for itself in that the limitations within the claim (and their equivalents) are what the Applicant invented, and thereby contend will, *inter alia*, affect the business value of a company. For example, the Applicant is not contending that the identified solutions of the claimed invention are necessarily the only items that affect business value, only that the claimed invention is

novel and not obvious. Further, the use of the term “comprising” in the claims indicates that there may be other limitations even within the realm of the claimed invention. That is, while *other* factors, elements, items, things, etc. outside the claims *may* also affect business value, this does not, and should not, preclude the claimed invention from being definite.

Respectfully, it appears, that the Office is contending that, in the business management environment, various macroeconomic factors will also affect the business value of a company. Applicant concedes this. However, this does not render the claims indefinite for one of ordinary skill in the art can discern the claimed invention.

To this extent, Applicant respectfully submits that the claimed invention is clearly enabled in the specification and/or with the knowledge of one of ordinary skill in the art of business management at the time of the invention. Accordingly, Applicant requests that the rejection be withdrawn.

C. §101 Rejection of Claims 1-4, 6-8 and 10-22

The Office has rejected claims 1-4, 6-8 and 10-22 for allegedly being directed to non-statutory subject matter. Specifically, the Office asserts that the claimed invention does not produce a useful, concrete, and tangible result.

Initially, Applicants respectfully submit that the relevant section of the United States Code recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. 35 U.S.C. §101.

To this extent, the code requires that the invention be “new and useful” and not that the result be “useful, concrete, and tangible” as asserted by the Office. The USPTO has chosen, in its Interim Guidelines, to use concreteness of the result and tangibility as factors in making a determination as to whether the invention is useful. However, the Guidelines themselves state that concreteness of the result and tangibility are not dispositive in and of themselves, but merely factors in determining whether the invention is useful.

As to whether the claimed invention is useful, the preambles of the claims themselves provide a use, to wit, “for identifying a solution to improve a business value of a company in an industry;” (Claim 1); and, “generating a value proposition for a company in an industry;” (Claims 6, 10, 11, 15, 18 and 22). These functions involve tangible and useful results as well as, an aspirational goal in the business management environment, namely improving business aspects of a company. To this extent, Applicant respectfully submits that the claimed invention is directed to statutory subject matter. Accordingly, Applicant requests that the rejection be withdrawn.

D. §103(a) Rejection of Claims 1-4, 6-8 and 10-22

Regarding claim 1, Applicant respectfully requests withdrawal of the rejection because neither Machin nor Sanders teaches, or suggests, each and every feature in claim 1, (see also claims 6, 10, 11, 15, 18 and 22). Further, the invention claimed invention is not obvious in view of Machin and Sanders.

Interpreting Machin and Sanders only for the purposes of this response, Applicant submits that, to the contrary, Machin does not teach or suggest any type of method that includes “**assessing** impacts of the solutions on the operational metrics **for the industry; after assessing, then comparing** a current operational performance of the company” (emphasis added), as in claim 1 of the present invention. To the contrary, Machin teaches and discloses, via its “gap versus solution optimizer report”, a method that employs a “summary of potential solutions available on the market for narrowing or eliminating that **gap**” (emphasis added). Col. 12, lines 17-21. Clearly, as Figure 14 shows, the suggested solutions and their various impacts (e.g., ROI, GapImpact, risk, etc.) are all in relation to how they may/may not effect the gap *in a specific company* and *not* first assessing impacts of solution on the metrics **for the industry**, as in the present invention (emphasis added). In fact, Machin is completely devoid of even a suggestion of first assessing the various impacts on operational metrics for an entire industry, as with the present invention, and then making any sort of comparison analysis. The Office agrees with the above statements regarding the lack of certain claimed elements in Machin (i.e., “assembling a set of solutions for application by the industry; assessing impacts of

application of the solutions on the operational metrics for the industry”). Office Action, page 7, item 12. Further, Sanders does not remedy this glaring deficiency in Machin.

In fact, Sanders entails a system, method, and apparatus for solution for value enhancement of an enterprise. Title. The Office cites column 14, lines 10-65, for support for disclosing this aspect of the present invention. However, a careful reading of the citing section, and Sanders as a whole, indicates that Sanders is applying its invention so as to analyze and render solutions to *a single “enterprise”*, and not, at first, to an industry as in the present invention. (Emphasis added). “The solution generator then delivers recommended solutions for value enhancement *of the enterprise*, with linkages to specific functions.” Col. 7, lines 35-37. (emphasis added). Clearly, as with Machin, Sanders only applies various methodologies to a single enterprise.

Accordingly, Applicant submits that there is no teaching or suggestion in either Machin or Sanders of any type of a method that first assesses the various solutions and their impacts on operational metrics in an entire industry, and then makes various comparisons and identifications regarding a specific company, as disclosed in claim 1. Therefore, Applicant respectfully requests withdrawal of the rejection of claim 1.

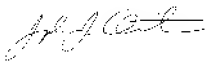
With respect to dependent claims 2-4, Applicant herein incorporates the arguments presented above with respect to the independent claim from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

Further, regarding independent claims 6, 10, 11, 15, 18 and 22 and dependent claims 7, 8, 12-14, 16, 17, and 19-21 Applicant contends that for the same reasons stated above, that these claims too are allowable and, accordingly, requests withdrawal of the rejections thereto.

IV. CONCLUSION

In light of the above remarks, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



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